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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Michael F. QUINN et al.

Group Art Unit: 3628

U.S. Serial No. 08/626,600

Examiner: Chencinski, Siegfried E.

Filed: April 2, 1996

For: **DOCUMENT STORAGE AND RETRIEVAL SYSTEM**

APPELLANTS' BRIEF ON APPEAL

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Per 37 C.F.R. § 1.192(c), this brief contains these items under the following headings, and in the order set forth below:

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## **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is the Assignee of record, Citibank, N.A., as evidenced by the Assignment recorded on April 2, 1996 at Reel 7938, Frame 0584.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' undersigned counsel, and Assignee are unaware of any appeal or interference that would have a direct effect upon the instant appeal, or that would be affected by the instant appeal, or that would have any bearing on the instant appeal.

## **III. STATUS OF THE CLAIMS**

### **A. Total Number of Claims in Application**

There is a total of 11 claims pending in this application, which are identified as Claims 33-43.

### **B. Status of All the Claims**

1. Claims canceled: Claims 1-32
2. Claims withdrawn from consideration but not canceled: NONE.
3. Claims pending: Claims 33-43.
4. Claims allowed: NONE.
5. Claims rejected: Claims 33-43.

### **C. Claims on Appeal**

The claims on appeal are: Claims 33-43.

#### **IV. STATUS OF AMENDMENTS**

Claims 33-43 were finally rejected in the Final Office Action dated June 30, 2003.

#### **V. SUMMARY OF INVENTION**

The invention is a method and system for organizing and retrieving documents and material associated with the documents. More particularly, the system is made up of a plurality of central data storage means (an example is described page 12, lines 4-10 and Figure 1, elements 118 and 120) that contain electronic folders (an example is described on page 12, lines 11-18) that are themselves comprised of bit mapped images (an example is described on page 12, lines 16-18; page), ASCII information about bit mapped images (original claim 1, line 7), messages (See page 7, lines 12-15 as an example) and completed inquiries (See page 7, lines 12-15 as an example). These folders are generally used to collect all relevant information, both paper and electronic, pertaining to a transaction in one location for ease of searching and organization (See the abstract). The system also contains a plurality of customer service units having local storage means (for example, see page 6, lines 5-15; page 13, line 20 - page 14, line 6; page 36, lines 15-17 and Figure 22, elements 1314-1330), a wide area network (See page 6, lines 5-8), means for inputting data (one example is given in Figure 1, element 136) and means for indexing input data (one example is given in Figure 1, element 138).

## **V. ISSUES**

The first issue is whether claims 33-37, 39-41, and 43 are unpatentable under 35 U.S.C. §103 over USP No. 5,168,444 (“Cukor”) and *Digital Imaging Technology: What, Where, and Why in Commercial Nuclear Power*, Nuclear Plant Journal, Jul. – Aug. 1991 (“Reding”).

The second issue is whether claim 38 is unpatentable under 35 U.S.C. §103 over Cukor and Reding as applied to claim 35, and further in view of *A Shortcut in the Paper Chase*, Distribution, v.93, n1, p. 42 (“Dysart”).

The third issue is whether claim 42 is unpatentable under 35 U.S.C. §103 over Cukor and Reding as applied to claims 35 and 36, and further in view of USP No. 5,490,217 (“Wang”).

## **VII. GROUPING OF CLAIMS**

For purposes of this Appeal Brief only, claims 35-42 stand or fall together. Claim 33 and claim 34 are each independent claims.

## **VIII. ARGUMENTS**

### **A. REJECTION UNDER 35 U.S.C. §103(a)**

Claims 33-37, 39-41, and 43 were rejected as being unpatentable under 35 U.S.C. §103 over Cukor and Reding.

The BPAI decision earlier in this matter (Appeal No. 2000-1442) pointed to certain features of the invention that were left unaddressed because these features were not recited in the claims that were presently before the Board. See BPAI Decision, p. 12. As a result, a CPA was

filed with amended claims to clearly include these features in the independent claims (claims 33, 34, 35). For example, the features include (1) checking to determine if a requested document is stored locally before requesting the data from a central site, and (2) the capacity of local memories to make such processes effective.

The Examiner rejected independent claims 33, 34, and 35 under 35 U.S.C. 103(a) as being unpatentable over Cukor and Reding. This rejection, as well as the rejections under 35 U.S.C. 103(a) of the dependent claims, are respectfully traversed.

As described in Applicants' specification, the present invention includes unique features at the local customer service units, such as, the option of being able to restrict users to only retrieve images that are locally stored, and not being able to access documents across the network. Specifically,

System administrators [however,] may **restrict user workstations to only retrieve images from the local storage devices.**

*Appl. Spec.*, p. 6, lines 24-26 (emphasis added).

This feature is not shown or suggested by Cukor. Cukor indeed teaches away from such capabilities by only referring to retrieving documents from a central source and providing very limited local memory. See col. 6, lines 43-48. Essentially, because of the limited memory, the images scanned locally are constantly replaced and thus irretrievable at the local level. This is further supported by Cukor's disclosure in col. 7, lines 21-25 that the centralized processing site forwards images to the remote stations in order to fulfill customer inquiries. Accordingly, it is respectfully submitted that the local memory limitation recited in the present claims should be accorded weight, especially in view of other recited limitations, for example, that of checking to

determine if a requested document is stored locally before requesting the data from a central site. Without sufficient local memory, these other limitations would not serve a meaningful purpose.

As noted below Applicants' specification elaborates on the context of the "escalation scheme" of determining whether a requested document is stored locally before requesting the data from a central site. More particularly, the present invention provides for multiple formats of the same image to be stored at different locations. Therefore, different local sites may use different image management packages, and requested images are first checked locally before being requested from a central site. Specifically, the specification notes,

Since the image management and data management systems are separate modules, users have the option of using different management software. Two features of the trade records information management system of the present invention allow this functionality. First, the relational database has been designed to **allow for multiple locations and formats of images for each document**. This means that the same image can be stored in different locations, or **even different image management systems**. Second, the front-end application uses specific functions to retrieve images. By replacing or upgrading these functions for different sites, different image management packages can be used. Additionally, the front-end image retrieval function will allow for an **escalation scheme to determine if an image that is not stored locally** should be retrieved across the network.

*Appl. Spec.*, p. 54, lines 9-22 (emphasis added). Cukor's system does not check to determine if the requested document is stored locally before requesting the data from the central processing site, and therefore cannot offer advantages related to different image formats. For at least this reason, coupled with the fact that Cukor's local memory is severely limited, Cukor does not show or suggest the claimed limitations. Cukor simply holds images up until they are

transmitted to the central processing site as stated in column 11, lines 1-3 (“[t]he document images are retained on the magnetic storage at the remote stations until the archive acknowledgment signal is received.”) (emphasis added). See also column 10, lines 50 - 54.

Essentially, the Examiner improperly uses hindsight to justify the rejection of the claims. Contrary to the Examiner’s assertions, Cukor does not “reasonably suggest” but rather teaches away from the claimed invention.

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself... Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988) (emphasis added).

In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention. *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988) (emphasis added).

For the foregoing reasons, it is respectfully submitted that the application is in condition for allowance in view of the cited prior art.

B. REJECTION UNDER 35 U.S.C. §103(a)

Claim 38 was rejected as being unpatentable under 35 U.S.C. §103 over Cukor and Reding as applied to claim 35, and further in view of Dysart.



Because claim 38 depends from claim 35, the arguments presented above are equally applicable to claim 38.

C. REJECTION UNDER 35 U.S.C. §103(a)

Claim 42 was rejected as being unpatentable under 35 U.S.C. §103 over Cukor and Reding as applied to claims 35 and 36, and further in view of Wang.

Because claims 42 and 36 depend from claim 35, the arguments presented above are equally applicable to claims 42 and 36.

D. CONCLUSION

For the reasons advanced above, Appellants respectfully contend that claims 33-43 are patentable over the cited references. Accordingly, a reversal of the final rejection is respectfully requested. If any fees are required in connection with this filing, the Commissioner is hereby authorized to charge Deposit Account no. 501458.

Respectfully submitted,

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## **IX. APPENDIX OF CLAIMS INVOLVED IN THIS APPEAL**

### **1. - 32. Cancelled.**

33. A trade records information management system for storing, searching, and retrieving data pertaining to financial transactions, comprising:

a plurality of central data storage means maintained at a plurality of regional processing centers, each central data storage means includes means for storing transaction data folders which contain bit mapped images, ASCII information about the bit mapped images, messages and completed inquiries;

a plurality of customer service units that are remote from each of the plurality of regional processing centers, each customer service unit having local data storage means of at least 500 megabytes of memory maintained at the customer service units, the local data storage means includes means for storing the transaction data folders which contain the bit mapped images and messages and completed inquiries;

means for transmitting the bit mapped images to the customer service units after determining that the bit mapped images are not electronically stored at the customer service units;

a wide area network connecting each regional processing center with at least one customer service unit in a set associated with each of the plurality of regional processing centers and connecting the plurality of regional processing centers together;

means for inputting data into each of the plurality of central data storage means from a plurality of sources, the means including means for creating and inputting bit mapped images of hard copy documents;

means for indexing input data in the central data storage means and creating the transaction data folder related to the transaction, each of the transaction data folders containing a unique identifier and at least one bit mapped image file of the at least one hard copy document wherein the bit mapped image file of hard copy documents related to the transaction are stored in the transaction data folder;

γ means for searching the data storage means in response to structured queries and identifying records that match the queries;

γ graphic user interface means for allowing users to build the structured queries;

5 means for displaying data in the local data storage means so as to enable the transaction data folder to be reviewed;

4 means for allowing the user to monitor another user's work-in-process at any time to monitor the backlog and assigned levels of work and means for assigning monitoring privileges to select users;

6 means for assigning the transaction data folder to the user based upon a predetermined routing procedure;

7 means for creating a work queue for the users;

8 means for allowing the user to exchange database data;

9 means for maintaining the internal unique identifier to identify the transaction data folder and document with an image transaction ID number;

12 means for retrieving identified data records from one of the plurality of central data storage means in response to the structured queries and replicating data records retrieved from the central data storage means in the local data storage means;

gateway means located at each of the plurality of regional processing centers, for linking the central data storage means with the local data storage means at each of the customer service units and linking the wide area network to other networks;

wherein the gateway means is comprised of means for converting image data to and from a stored image format;

10 wherein the transaction data folders can be accessed by customer service representatives at any network location; and

wherein the plurality of customer service units are divided into a plurality of the sets, each set containing at least one customer service unit, where each set of customer service units is associated with one of the plurality of regional processing centers.

34. A process of trade records information management system for storing, searching, and retrieving data pertaining to financial transactions comprising the steps of:

preprocessing inbound paper-based documents including scanning the inbound paper-based documents;

indexing the inbound paper-based documents;

storing bit mapped images;

storing ASCII information about the bit mapped images;

storing messages and completed inquiries;

inputting data into a central data storage means from a plurality of sources;

indexing input data in the central data storage means and creating a transaction data folder, the transaction data folder containing a unique identifier and a bit mapped image file containing an image of at least one paper-based document, ASCII information about the at least one paper-based document, messages and completed inquiries;

15 assigning the transaction data folder to a particular user based upon predetermined routing rules;

16 creating a queue for the particular user, the queue containing documents and inquiries for processing;

17 monitoring document work flow for backlog and assigned work levels;

18 connecting regional processing centers with a plurality of customer service units through a wide area network linking the central data storage means with local data storage means at each of the customer service units and linking the wide area network to other networks to allow data communication between the data storage means and the networks;

19 searching the data storage means in response to structured queries and identifying records that match the queries;

20 maintaining an internal unique key identifier to identify each of the transaction data folder and documents with an image transaction ID number; and

transmitting the bit mapped images to the customer service unit, the customer service unit having at least 500 megabytes of memory, wherein a determination is first made that the bit mapped images are not locally stored at the customer service unit.

*new feature*

23 35. A method of managing documents and messages associated with a financial transaction in a system comprising:

scanning at least one paper document associated with the financial transaction to generate at least one bit mapped image of the at least one paper document at a first site;

transmitting the at least one bit mapped image to a first regional processing center;

retrieving the at least one bit mapped image at a local trade records information management system from the first regional processing center after determining that the at least one bit mapped image is not electronically stored at the local trade records information management system;

indexing the at least one bit mapped image at the local trade records information management system;

creating a first transaction folder image at the local trade records information management system wherein the first transaction folder contains information related to the financial transaction including the at least one bit mapped image and messages;

storing the first transaction folder at both the local trade records information management system and the first regional processing center; and

retrieving information within the first transaction folder from either the first regional processing center or the local trade records information management system;

wherein a user may access the first transaction folder at the local trade management information system when the regional processing center is off-line. *new feature 28*

36. The method of managing documents and messages associated with the financial transaction in the system of claim 35, wherein the user may access information within the first transaction folder stored at the regional processing center directly. *29*

37. The method of managing documents and messages associated with the financial transaction in the system of claim 35, wherein the user may transfer the bit mapped image in the first transaction folder into a second transaction folder. *30*

38. The method of managing documents and messages associated with the financial transaction in the system of claim 35, wherein storing of the first transaction folder at the regional processing center occurs at night and the storing of the first transaction folder at the local trade records information management system occurs during the day. *31*

39. The method of managing documents and messages associated with the financial transaction in the system of claim 35 comprising:

connecting the first regional processor center with a second regional processor center such that a second remote site can access the first transaction folder stored in the first regional processor center via the second regional processor center. 32

40. The method of managing documents and messages associated with the financial transaction in the system of claim 35, wherein any data input into the system by the first site must be routed to the local trade records information management system in order to be placed into the first transaction folder. 24

41. The method of managing documents and messages associated with the financial transaction in the system of claim 36, wherein the first transaction folder is a new transaction folder created by the local trade records information management system. 25

42. The method of managing documents and messages associated with the financial transaction in the system of claim 36, wherein the first transaction folder is a pre-existing transaction folder. 26

43. The method of managing documents and messages associated with the financial transaction in the system of claim 36, wherein the information related to the financial transaction which is stored within the first transaction folder is further comprised of inbound fax messages. 27